

## **REMARKS**

The office action of March 6, 2006 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1 through 4, 6 through 10, and 12 remain in this case, claims 1 and 7 being amended and claims 5 and 11 being cancelled by the present response. No new matter has been added by these amendments. The claims have been amended only to overcome the 112 rejection and to clarify claim 1 and claim 7, not to overcome the cited prior art.

The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.

### **Objections to the Drawings**

1. The drawings were objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "25, 26, and 27" have been used to designate both the "bolt holes" and the "bolt shafts" (see page 8, lines 15-26).

The reference numerals in Figures 1 through 2C, Figures 4 through 5C, and Figures 7 through 10C have been amended such that the bolt shafts (5'), (6'), (7'), (25'), (26'), (27'), (44'), (45'), (51), (52), and (61') are labeled with different reference numerals than the bolt holes (5), (6), (7), (25), (26), (27), (44), (45), (59), (60), and (61). The reference numerals in the specification have been changed to correspond with the changes to the figures. No new matter has been added by these amendments. The amendments to the figures are fully supported by the specification as filed.

2. The drawings were objected to under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims. Specifically, the Examiner states that the claimed mounting surface and the claimed bolts must be shown in the figures or cancelled from the claims.

Figure 4 has been amended to show a mounting surface (28) having at least two bolt holes (25), (26), (27), and the reference numerals in the specification have been changed to correspond with the changes to the figures. Fig. 11 has been added to show a bolt, and reference

numerals have been added to the specification. No new matter has been added by these amendments. The amendments to the figures are fully supported by the specification as filed.

Reconsideration and withdrawal of the objections are respectfully requested.

### **Rejection under 35 U.S.C. §112**

4. Claims 1, 5, 7, and 11 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Regarding claims 1 and 7, the Examiner states that "slightly smaller" renders the claims indefinite. Claims 1 and 7 have been amended to delete the term "slightly".

Regarding claims 5 and 11, the Examiner states that "an ambient temperature" renders the claims indefinite. Claims 5 and 11 have been cancelled by the present response.

Applicant believes that these amendments have fully addressed the Examiner's rejections, and the claims are now in condition for allowance. Reconsideration and withdrawal of the rejection are respectfully requested.

### **Rejection under 35 U.S.C. §103**

5. Claims 1-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gröger *et al.* (U.S. Patent No. 4,832,664) in view of Kato (U.S. Patent No. 6,296,432). Applicant respectfully disagrees with the rejection.

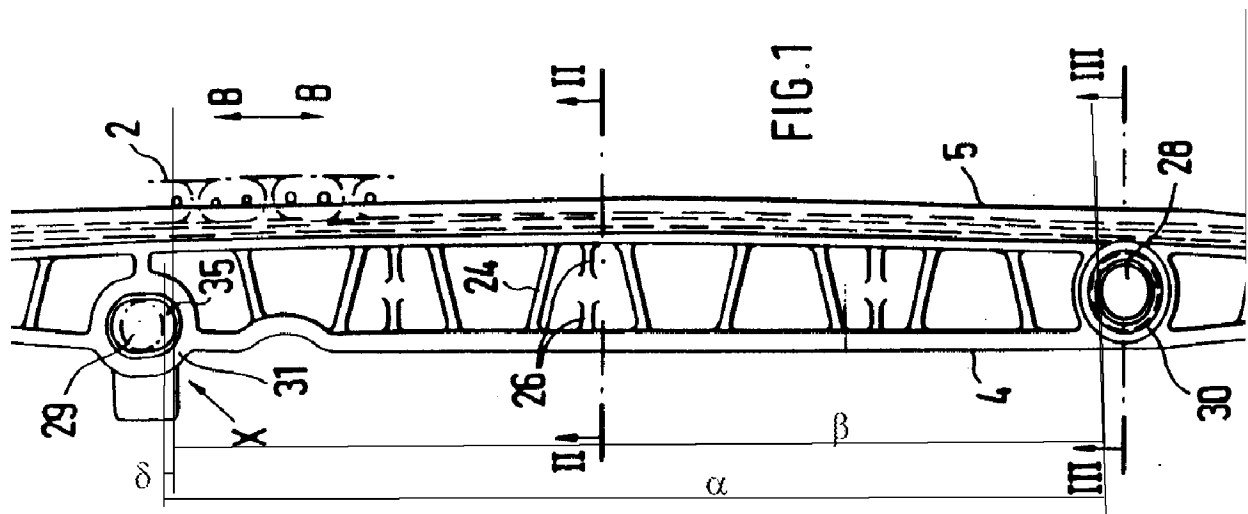
The basic considerations which apply to obviousness rejections under MPEP Section 2141 are:

- (1) the claimed invention must be considered as a whole;
- (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(4) reasonable expectation of success is the standard by which obviousness is determined.

Amended independent claim 1 claims, in part, "a plurality of bolts each comprising ... a bolt shaft ... wherein the bolt is mountable in the bolt holes, and wherein nearest edges of the bolt shafts of each pair of bolts, when mounted, are spaced apart by a first distance" and "a chain guide having at least two bolt slots for receiving the bolts ... nearest edges of each pair of bolt slots of the chain guide, when mounted, being spaced apart by a second distance, wherein at an operating temperature for at least one pair of bolt shafts and their respective pair of bolt slots the first distance is equal to or smaller than the second distance such that the bolt shafts contact the nearest edges of the bolt slots".

Gröger teaches a guide rail consisting of a plastic material with a slideaway lining body and a carrier. The body and the carrier are connected by dovetail connections. The Examiner points to Fig. 1 of Gröger. The Examiner states that in Fig. 1 the first distance between bearing pins (28), (29) is equal to or slightly smaller than the second distance between slots (30), (31) such that the pins (28), (29) contact the nearest edges of the slots (30), (31). In Fig. 1, Gröger indicates bearing pin (29) as a dotted/dashed circle inside a clearly larger oval-shaped slot (31). The bearing pin (29) is located approximately in the center of the slot (31). The bearing pin (29) does not appear to contact any edge of the slot (31) and clearly does not contact the edge of the slot nearest to the other slot (30). There is a large gap between the edge of the bearing pin (29) and the slot (31) in Fig. 1. Therefore, the distance between the nearest edges of the bearing pins (28), (29) in Fig. 1 of Gröger must be greater than the distance between the nearest edges of the slots (30), (31). In the figure below, which shows the relevant parts of Fig. 1 of Gröger, the equivalent to Applicant's first distance (nearest edges of pin shafts) is labeled as  $\alpha$ , and the equivalent to Applicant's second distance (nearest edges of slots) is labeled as  $\beta$ . The difference between these two distances is labeled as  $\delta$  below. In the prior art figure, the first distance is clearly greater than the second distance by the measureable amount  $\delta$ . Therefore, Gröger does not teach or suggest a "first distance ... equal to or smaller than [a] second distance" as claimed in amended independent claim 1.



Gröger does not teach or suggest a distance between nearest edges of bearing pins equal to or less than a distance between nearest edges of their respective slots such that the pins contact the nearest edges of the bolt slots.

Kato does not provide what Gröger lacks. Kato teaches a bolt guided by an engaging spiral guide groove to prevent encroaching, seizure, and racing between the bolt and its nut. Kato does not teach or suggest a chain guide having slots or a mounting surface for mounting bolts. Kato does not teach or suggest nearest edges of the bolt shafts of each pair of bolts, when mounted, spaced apart by a first distance. Kato does not teach or suggest a chain guide having at least two bolt slots for receiving the bolts. Kato also does not teach nearest edges of each pair of bolt slots of the chain guide, when mounted, being spaced apart by a second distance, wherein for at least one pair of bolt shafts and their respective pair of bolt slots the first distance is equal to or smaller than the second distance such that the bolt shafts contact the nearest edges of the bolt slots.

Neither Gröger or Kato, alone or in combination, teach or suggest the Applicant's independent claim 1. Therefore, it is respectfully suggested that the rejection of independent claim 1 as being obvious over Gröger in view of Kato is overcome. Dependent claims 2-4 and 6, being dependent upon and further limiting independent claim 1, should also be allowable for that reason, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejection are respectfully requested.

Amended independent claim 7 claims, in part, "at least two bolt holes spaced apart by a first distance between nearest edges of the bolt holes ...and a chain guide having a bolt slot corresponding to each bolt hole and spaced apart by a second distance between nearest edges of the bolt slots ... wherein at an operating temperature the first distance is equal to or smaller than the second distance such that the bolts contact the nearest edges of the bolt slots".

Gröger teaches a guide rail consisting of a plastic material with a slideaway lining body and a carrier. The body and the carrier are connected by dovetail connections. The Examiner points to Fig. 1 of Gröger. The Examiner states that in Fig. 1 the first distance between bearing pins (28), (29) is equal to or slightly smaller than the second distance between slots (30), (31) such that the pins (28), (29) contact the nearest edges of the slots (30), (31). Gröger does not teach or suggest mounting holes for the pins. In Fig. 1, Gröger indicates bearing pin (29) as a dotted/dashed circle inside a clearly larger oval-shaped slot (31). Gröger does not teach or suggest mounting holes for the pins. The bearing pin (29) is located approximately in the center of the slot (31). The bearing pin (29) does not appear to contact any edge of the slot (31) and clearly does not contact the edge of the slot nearest to the other slot (30). There is a large gap between the edge of the bearing pin (29) and the slot (31) in Fig. 1. Therefore, the distance between the nearest edges of the bearing pins (28), (29) in Fig. 1 of Gröger must be greater than the distance between the nearest edges of the slots (30), (31).

Gröger does not teach or suggest a distance between nearest edges of holes for bearing pins equal to or less than a distance between nearest edges of their respective slots such that the pins contact the nearest edges of the bolt slots.

Kato does not provide what Gröger lacks. Kato teaches a bolt guided by an engaging spiral guide groove to prevent encroaching, seizure, and racing between the bolt and its nut. Kato does not teach or suggest a chain guide having slots or a mounting surface for mounting bolts. Kato does not teach or suggest nearest edges of the bolt holes of each pair of bolts, when mounted, spaced apart by a first distance. Kato does not teach or suggest a chain guide having at least two bolt slots for receiving the bolts. Kato also does not teach nearest edges of each pair of bolt holes of the chain guide being spaced apart by a second distance, wherein the first distance

is equal to or smaller than the second distance such that the bolts contact the nearest edges of the bolt slots.

Neither Gröger or Kato, alone or in combination, teach or suggest the Applicant's independent claim 7. Therefore, it is respectfully suggested that the rejection of independent claim 7 as being obvious over Gröger in view of Kato is overcome. Dependent claims 8-10 and 12, being dependent upon and further limiting independent claim 7, should also be allowable for that reason, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejection are respectfully requested.

### **Rejection under 35 U.S.C. §102**

8. Claims 1, 6, 7, and 12 were rejected under 35 U.S.C. 102(a) as being anticipated by prior art Figures 1-2C of the present application. Applicant respectfully disagrees with the rejection.

"Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation." *Stauffer v. Slenderella Systems of California, Inc.*, 254 F.2d 127, 115 USPQ 347 (9th Cir. 1957).

Amended independent claim 1 claims, in part, "a plurality of bolts each comprising ... a bolt shaft ... wherein the bolt is mountable in the bolt holes, and wherein nearest edges of the bolt shafts of each pair of bolts, when mounted, are spaced apart by a first distance" and "a chain guide having at least two bolt slots for receiving the bolts ... nearest edges of each pair of bolt slots of the chain guide, when mounted, being spaced apart by a second distance, wherein at an operating temperature for at least one pair of bolt shafts and their respective pair of bolt slots the first distance is equal to or smaller than the second distance such that the bolt shafts contact the nearest edges of the bolt slots".

In Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C of the present application, which the Applicant has presented as prior art, the chain guide has three bolt slots (2), (3), (4) and is mounted on three bolt shafts (5'), (6'), (7'). In Fig. 2B, the first distances (11), (12) between the nearest edges of the center (6') and right (7') and the left (5') and right (7') bolt shafts, respectively, are labeled. There

is also an unlabeled first distance between the nearest edges of the left (5') and the center (6') bolt shafts. In Fig. 2C, the second distances (13), (14) between the nearest edges of the center (3') and right (4') and the left (2') and right (4') bolt slots, respectively, are labeled. There is also an unlabeled second distance between the nearest edges of the left (2') and the center (3') bolt slots. First distance (11) is greater than second distance (13). First distance (12) is greater than second distance (14). The first distance between the nearest edges of the left (5') and the center (6') bolt shafts is greater than the second distance between the nearest edges of the left (2') and the center (3') bolt slots.

Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C disclose a chain guide wherein each of the first distances is greater than its respective second distance. Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C disclose bolt shafts that do not contact the nearest edges of the bolt slots. Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C do not disclose a first distance equal to or smaller than a second distance such that the bolt shafts contact the nearest edges of the bolt slots. Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C do not disclose each and every limitation of independent claim 1.

Therefore, it is respectfully suggested that the rejection of independent claim 1 as being anticipated by Figures 1-2C of the present application is overcome. Dependent claim 6, being dependent upon and further limiting independent claim 1, should also be allowable for that reason, as well as for the additional recitations it contains. Reconsideration and withdrawal of the rejection are respectfully requested.

Amended independent claim 7 claims, in part, "at least two bolt holes spaced apart by a first distance between nearest edges of the bolt holes ...and a chain guide having a bolt slot corresponding to each bolt hole and spaced apart by a second distance between nearest edges of the bolt slots ... wherein at an operating temperature the first distance is equal to or smaller than the second distance such that the bolts contact the nearest edges of the bolt slots".

In Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C of the present application, which the Applicant has presented as prior art, the chain guide has three bolt slots (2), (3), (4) and is mounted on three bolt shafts (5'), (6'), (7'). In Fig. 2B, the first distances (11), (12) between the nearest edges of the center (6) and right (7) and the left (5) and right (7) bolt holes, respectively, are labeled. There is also an unlabeled first distance between the nearest edges of the left (5) and the center (6) bolt

holes. In Fig. 2C, the second distances (13), (14) between the nearest edges of the center (3') and right (4') and the left (2') and right (4') bolt slots, respectively, are labeled. There is also an unlabeled second distance between the nearest edges of the left (2') and the center (3') bolt slots. First distance (11) is greater than second distance (13). First distance (12) is greater than second distance (14). The first distance between the nearest edges of the left (5) and the center (6) bolt holes is greater than the second distance between the nearest edges of the left (2') and the center (3') bolt slots.

Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C disclose a chain guide wherein each of the first distances is greater than its respective second distance. Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C disclose bolt shafts that do not contact the nearest edges of the bolt slots. Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C do not disclose a first distance equal to or smaller than a second distance such that the bolt shafts contact the nearest edges of the bolt slots. Fig. 1, Fig. 2A, Fig. 2B, and Fig. 2C do not disclose each and every limitation of independent claim 7.

Therefore, it is respectfully suggested that the rejection of independent claim 7 as being anticipated by Figures 1-2C of the present application is overcome. Dependent claim 12, being dependent upon and further limiting independent claim 7, should also be allowable for that reason, as well as for the additional recitations it contains. Reconsideration and withdrawal of the rejection are respectfully requested.

#### **Requirement for Information Under 37 CFR §1.105**

9. The Examiner stated that the Applicant and the Assignee of this application are required under 37 CFR 1.105 to provide information that the Examiner has determined is reasonably necessary to the examination of this application.

The Examiner is requiring citation and a copy of each publication known by the Assignee describing the technology disclosed in the admitted prior art (Fig. 1 through Fig. 2C of the present application) and any information pertaining to the use, sale, or demonstration of the admitted prior art in this or any other country.

Regarding the Applicant, Andrew C. Shum, he worked for the Assignee for less than a year and no longer works for the Assignee or, to the Assignee's knowledge, in the automotive



industry. The Assignee is no longer in contact with the Applicant, but letters notifying the Applicant of this Requirement have been sent to the Applicant's last known address and to the address of a parent of the Applicant. No response from the Applicant has been received to date, but any Information received from the Applicant will be forwarded immediately to the USPTO.

The prior art figures in the application are based on guides sold by the Assignee. Included in this response are two designs sold by the Assignee to Volkswagen. They show chain guides having three mounting slots. The top mounting slot on the chain guide in the "VW EA 111FSI" system is clearly oblong, but the mounting pins or bolts are not shown in the figure. The "VW EA 111FSI" system was sold to Volkswagen for model year 2002 automobiles. The system was offered for sale to Volkswagen in 1999 or 2000 and sold to Volkswagen in 2001. The system was first sold in Europe.

U.S. Patent No. 4,832,664, provided to the USPTO in an IDS dated 4/9/04 for this application, is a two-slot rather than three-slot prior art embodiment with mounting pins rather than bolts, but otherwise the embodiment in Fig. 1 of this patent is an example of what the Applicant is describing as the prior art exhibited in Fig. 1 through Fig. 2C of the present application.

Assignee believes that the above Information includes all that is known and readily available to the Assignee. Assignee believes that this statement satisfies the requirements to file a Requirement for Information under 37 CFR §1.105. If the Examiner disagrees, or believes for any other reason that direct contact with Assignee's agent would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

### **Conclusion**

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:

--Andrew C. Shum--

By:                     /KLH #57457/                    

--Kraig Haverstick, Reg. No. 57,457--

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